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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,791	11/05/2001	Perry G Caimi	BB-1356USPCT	5803

23906 7590 02/17/2004

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WILMINGTON, DE 19805

EXAMINER
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BUI, PHUONG T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/009,791	<b>Applicant(s)</b> CAIMI ET AL.	
	<b>Examiner</b> Phuong T. Bui	<b>Art Unit</b> 1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14 and 19, drawn to a polynucleotide, first method of making and first method of using said polynucleotide.

Group II, claim(s) 15-18, drawn to a polypeptide.

Group III, claim(s) 20, drawn to a second method of using the polynucleotide.

In addition to electing one from Groups I-III above, Applicant is further required to elect one from Inventions A-R below.

- A. SEQ ID NO:1 or a sequence encoding SEQ ID NO:2
- B. SEQ ID NO:3 or a sequence encoding SEQ ID NO:4
- C. SEQ ID NO:5 or a sequence encoding SEQ ID NO:6
- D. SEQ ID NO:7 or a sequence encoding SEQ ID NO:8
- E. SEQ ID NO:9 or a sequence encoding SEQ ID NO:10
- F. SEQ ID NO:11 or a sequence encoding SEQ ID NO:12
- G. SEQ ID NO:13 or a sequence encoding SEQ ID NO:14
- H. SEQ ID NO:15 or a sequence encoding SEQ ID NO:16
- I. SEQ ID NO:17 or a sequence encoding SEQ ID NO:18
- J. SEQ ID NO:19 or a sequence encoding SEQ ID NO:20
- K. SEQ ID NO:21 or a sequence encoding SEQ ID NO:22
- L. SEQ ID NO:23 or a sequence encoding SEQ ID NO:24
- M. SEQ ID NO:25 or a sequence encoding SEQ ID NO:26
- N. SEQ ID NO:27 or a sequence encoding SEQ ID NO:28
- O. SEQ ID NO:29 or a sequence encoding SEQ ID NO:30
- P. SEQ ID NO:31 or a sequence encoding SEQ ID NO:32
- Q. SEQ ID NO:33 or a sequence encoding SEQ ID NO:34
- R. SEQ ID NO:35 or a sequence encoding SEQ ID NO:36

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2. The inventions listed as Groups I-III and Inventions A-R do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Inventions I and II represent structurally and functionally different molecules. Moreover, the polypeptides may be produced without using the polynucleotides, such as isolating the polypeptides from their native source. Inventions I and III represent divergent processes of using the polynucleotide.

Inventions A-R are structurally, chemically and biologically distinct sequences isolated from different sources and thus do not relate to a single general inventive concept. Since Applicant's claimed sequences encode structurally divergent COI1 species, they lack unity of invention.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong T. Bui whose telephone number is 571-272-0793. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phuong T. Bui  
Primary Examiner  
Art Unit 1638

2/7/04

ptb